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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,684	06/21/2006	Jose Blanco Gutierrez	IPK-27	9440
20808 7590 03/11/2010 BROWN & MICHAELS, PC 400 M & T BANK BUILDING 118 NORTH TIOGA ST ITHACA, NY 14850				
EXAMINER FETSUGA, ROBERT M				
ART UNIT		PAPER NUMBER		
3751				
NOTIFICATION DATE		DELIVERY MODE		
03/11/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@bpmlegal.com
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Office Action Summary

Application No.

10/596,684

Applicant(s)

GUTIERREZ ET AL.

Examiner

Robert M. Metsuga

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date 04/09/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The disclosure is objected to because of the following informalities: Page 11, line 7 and page 12, line 11, "9" denotes different elements; page 11, line 8 and page 12, line 11, the "fork" is designated by different numerals; and page 11, line 18 and page 12, line 24, "6" denotes different elements. Appropriate correction is required.
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Proper antecedent basis for the recitation at lines 6-7 of claim 5 (and similarly claim 8) could not be found in the specification. Applicant is reminded claim terminology in mechanical cases should appear in the descriptive portion of the specification by reference to the drawing(s).
3. Claims 5-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 5 recites a push-button 11 and functioning of the water saving device to release water upon actuation of the push-button. Claim 8 recites similar subject matter. There is

little, if any, clarifying description in the specification as to how the push-button performs the recited function. Page 12, lines 10-14 are noted, however, the operation discussed is not evident from the illustrations of Figs. 1-3, particularly with regard to the apparent movement of the handle 9.

4. Claims 8, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is ambiguous as attempting to embrace two different statutory classes of invention. The claim preamble recites a "method", but the body thereof injects product/apparatus structure and steps of using that structure. See MPEP 2173.05(p) (II). Claims 11 and 12 inject additional structure into the "method".

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 6 and 8-11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Walsh.

The Walsh reference discloses a water-saving device comprising: a "single push-button" 35 (col. 3 lns. 44-49); an overflow pipe 20 including a sealing disc/discharge valve 15,16; a float 19; and a variable, adjustable (col. 6 lns. 1-6) weight 36 including lower openings 38, as claimed. With regard to pressing the push-button a second time, note column 5, lines 44-66.

7. Claims 5, 6 and 8-11, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh and Ho.

Re claim 5, although the lever 35 of the Walsh flush valve may not include a push-button, as applicant discloses, attention is directed to the Ho reference which discloses an analogous flush valve which further includes a lever 16 having a push-button 25. Therefore, in consideration of Ho, it would have

been obvious to one of ordinary skill in the flush valve art to associate a push-button with the Walsh lever in order to enable flush mounting to a cistern cover.

8. Claims 7 and 12, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh alone, or taken with Ho, as applied to claims 5 and 8 above, and further in view of Chang.

The Walsh weight includes a deposit (Fig. 1) and an axial opening 37.

Although the height adjustment of the Walsh float does not include a pivot and notches, as claimed, attention is directed to the Chang reference which discloses an analogous float 30 which further includes a pivot 34 and notches 36. Therefore, in consideration of Chang, it would have been obvious to one of ordinary skill in the float art to associate a pivot and notches with the Walsh height adjustment in order to positively maintain a desired position.

9. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

10. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886

Art Unit: 3751

who can be most easily reached Monday through Thursday. The

Office central fax number is 571/273-8300.

/Robert M. Fetsuga/
Robert M. Fetsuga
Primary Examiner
Art Unit 3751